

REMARKS

I. Status of the Application

Claims 1-22 are pending in this application, subject to the foregoing amendments. In the August 16, 2007 office action, the Examiner objected to claims 1-12 and also rejected claims 1-12 under 35 U.S.C. § 112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In addition, the Examiner rejected claims 1-12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,715,390 to Hoffman et al. (hereinafter "Hoffman"), in view of U.S. Patent No. 4,918,728 to Matyas et al. (hereinafter "Matyas"), and further in view of U.S. Patent No. 6,067,622 to Moore et al. (hereinafter "Moore"). The Examiner also rejected claims 13-20 under 35 U.S.C. § 103(a) as being unpatentable over Hoffman, in view of Matyas, in view of Moore, and further in view of U.S. Patent Publication No. 2004/0264701 to Lee et al. (hereinafter "Lee").

In this response, Applicant traverses the Examiner's rejection of claims 1-20. Applicant has also added new claims 21 and 22.

II. The Objection to Claims 1-12 Should be Withdrawn

In the August 16, 2007 Office action, the Examiner objected to claims 1-12 alleging that the term "ANSI C12.19" is an industry standard or trademark. Applicant submits that the ANSI C12.19 standard is a very specific, definite and identifiable standard and does not

render the claims indefinite. However, Applicant has amended claim 1 to remove the term “ANSI C12.19”. Accordingly, the examiner’s objection to claims 1-12 should be withdrawn.

III. The Examiner’s Rejection of Claims 1-12 Under 35 U.S.C. § 112 Second Paragraph Should be Withdrawn

In the August 16, 2007 office action, the Examiner rejected claims 1-12 under 35 U.S.C. § 112, second paragraph, alleging that the term “Decade4 table parameters” of claim 1 rendered the claims indefinite. Applicant submits that the term “Decade4 table parameters” in relation to ANSI C12.19 are very specific, definite and identifiable parameters which do not render the claims indefinite. However, Applicant has amended claim 1 to remove the term “Decade4 table parameters”. Accordingly, the examiner’s objection to claims 1-12 should be withdrawn.

IV. The Examiner’s Rejection of Claims 1 Under 35 U.S.C. § 103(a) Should be Withdrawn

In the April 19, 2007 office action, the Examiner rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Hoffman in view of Matyas, and further in view of Moore. In this response, Applicant respectfully traverses the Examiner’s rejection of claim 1 under 35 U.S.C. § 103(a), as the Examiner has failed to make a *prima facie* case of obviousness as described in MPEP § 2142-2143.

The Examiner’s rationale for a finding of obviousness in the August 16, 2007 Office action is unclear. However, Applicant notes that pursuant to MPEP 2143, “the key to

supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” Furthermore, in order to establish a *prima facie* case of obviousness, three basic criteria should be met as set forth in MPEP § 2143.01-2143.03. First, there must be some suggestion or motivation to modify the references or combine reference teachings. MPEP § 2143.01. Second, there must be a reasonable expectation of success. MPEP § 2143.02 Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143.03

A. The References Do Not Teach or Suggest All Claim Limitations

1. Hoffman Does Not Disclose The Cited Limitations of Claim 1

In the present case, it is respectfully submitted that the Examiner has failed to make a *prima facie* case of obviousness for at least the reason that neither Hoffman, Matyas, nor Moore teach or suggest all the limitations of claim 1, either alone or in combination.

One example of a limitation of claim 1 that is not taught or suggested by the cited references is that of “an internally generated access key.” The Examiner suggested on page 4 of the August 16, 2007 office action, that the read-protected passwords in the RAM of Hoffman and the internally generated access key of claim 1 are equivalent. As outlined below, significant differences exist between the internally generated password of claim 1 and the read protected passwords of Hoffman, and they would not be equivalent to one of ordinary skill in the art at the time of the invention.

In addition to the above, at page 4 of the August 16, 2007 Office action, after stating that Hoffman’s read protected password is equivalent to an “internally generated access key”, the examiner inexplicably references Moore and states that “it would have been obvious to

one of ordinary skill in the art ... to modify Hoffman with the internally generated access install key [of Moore] to enhance security to prevent unauthorized data access operations.” Applicant respectfully submits that the foregoing statement concerning Moore is entirely unclear. The examiner made no suggestion that any limitation from claim 1 was missing from Hoffman but found in Moore. Instead, the examiner states that certain limitations are found in Hoffman but then states that it would be obvious to modify Hoffman to include features of Moore. Accordingly, it is unclear why the examiner references Moore. Is Hoffman missing a limitation from claim 1 (e.g., the “internally generated access key”)? Is this missing limitation found in Moore? Does the examiner cite Moore to reference some other limitation from claim 1? Clarification is respectfully requested. In particular, is the examiner’s position that the “internally generated access key” is or is not found in Hoffman? In view of this confusion, Applicant will address both Hoffman and Moore. In this subsection A, Applicant submits that an “internally generated access key” is not found in Hoffman. In subsection B, below, Applicant submits that the combination of Hoffman, Moore and Matyas is improper.

Hoffman does not disclose an “internally generated access key”. The electricity meter of Hoffman employs an enablement scheme aimed at reducing the possibility that an electricity meter upgrade password may be inappropriately used to upgrade more than one meter. The enablement scheme compares an externally generated password with a password stored within the meter’s nonvolatile RAM. **No passwords are internally generated in Hoffman.**

In contrast to Hoffman, claim 1 calls for an electricity meter employing an altogether different protection system. For example, claim 1 calls for an “internally *generated* an access

key". With such an internally generated access key, the utility meter of claim 1 could regularly enable an external device to access each security protected feature without depleting a limited number of stored passwords.

As set forth above, the Hoffman does not teach "an internally generated access key". Therefore it is respectfully submitted that the Examiner has failed to present prior art that teaches or suggests all the limitations of claim 1, and the Examiner has not made a *prima facie* case of obviousness and the 35 U.S.C. 103(a) rejection of claim 1 should be withdrawn.

2. The Examiner's Response to Applicant's Arguments Related to Hoffman Misapplies the Law

On page 18 of the August 16, 2007 Office action, the examiner responded to Applicant's arguments with respect to missing claim limitations in Hoffman. Applicant respectfully submits that the examiner misapplied the law related to the establishment of a *prima facie* case of obviousness on page 18 of the August 16, 2007 Office action.

In order to establish a *prima facie* case of obviousness, **three basic criteria** must be met under MPEP § 2143. **First**, there must be some suggestion or motivation to modify the references or combine reference teachings. MPEP § 2143.01 **Second**, there must be a reasonable expectation of success. MPEP § 2143.02 **Third**, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143.03 Applicant will refer to these criteria as the three prongs of obviousness in this response.

As set forth above and in Applicant's July 19, 2007 Response, Applicant submits that Hoffman does not teach or suggest all the limitations of claim 1. For example, Applicant

submits that Hoffman does not teach or suggest “an internally generated access key.”

Accordingly, applicant submits that the examiner has not met the **third prong** of a prima facie case of obviousness. The MPEP deals with this third prong of obviousness in MPEP 2143.03.

In the responding to Applicant’s arguments that Hoffman does not teach or suggest all claim limitations, the examiner in the August 16, 2007 Office action cites passages from MPEP 2143.01. In particular, the examiner stated that the following on page 18 of the Office action:

Hoffman teaches a method of gaining access to an electricity meter through the comparison of an external password with an internal password, which implicitly solves the nature of the problem as a whole; gaining access to the meter is key to any further operations. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art and the nature of the problem as a whole have suggested to those of ordinary skill in the art”, MPEP 2143.01.

In the above passage, the examiner appears to propose some new theory wherein a reference that somehow “implicitly solves the nature of the problem as a whole” is equivalent to a reference that actually discloses the claim limitation in dispute. The examiner cites MPEP 2143.01 in support of this position. However, it is respectfully submitted that **the examiner has misapplied the law and has taken the cited portion of MPEP 2143.01 completely out of context.** A careful reading of MPEP 2143.01 shows that this passage refers to the concept of combining references to establish the **first prong** of a prima facie case of obviousness. As set forth in MPEP 2143.01, an implicit suggestion in the references may be used in order to combine references. There is simply no support for the examiner’s proposition that a

reference which ‘implicitly solves the nature of the problem as a whole’ is equivalent to a reference that discloses a claim limitation for the purpose of meeting the third prong of a prima facie case of obviousness.

As set forth above, the examiner’s response to Applicant’s arguments in the July 19, 2007 Response has no basis in law. Furthermore, while Applicant’s argument that the examiner has not made a prima facie case of obviousness is related to the third prong of a prima facie case, the examiner’s response to arguments in the August 16, 2007 Office action recited passages from the MPEP related to the first prong of a prima facie case of obviousness. Moreover, the examiner has still not provided references which teach or suggest all limitations of claim 1, as required by the third prong of a prima facie case of obviousness. For example, the limitation of “an internally generated access key” from claim 1 is simply not found in Hoffman as suggested by the examiner.

In view of the above, it is respectfully submitted that the examiner has still not met the third prong of a prima facie case of obviousness by providing references that teach or suggest all the claim limitations, and the examiner’s rejection of claim 1 under 35 U.S.C. § 103 should be withdrawn.

B. There Is No Motivation to Combine Hoffman, Matyas and Moore

1. Hoffman

Hoffman discloses a method and apparatus for providing upgrades in electricity meters. In Hoffman, a security system is provided where a meter serial number is provided to an authentication algorithm in a computer 46 exterior to the meter. The authentication

algorithm generates a password. The password generated exterior to the meter is presented to the meter where the password is compared to a password in the RAM of the meter. If there is a match between the passwords, the requested upgrade command initiates. (See col. 4, lines 42-65 of Hoffman). As admitted by the examiner, Hoffman teaches a system in terms of security features, it does not explicitly describe a system to bypass security.

2. Moore

Moore discloses a software based system and method for reducing unlicensed software duplication, including a method for restricting hard-drive installation of software to authorized purchasers. In Moore, an install password is determined using an install password algorithm included with the software to be installed. The date and time is used to provide the install password. After this, a serial number from the software is passed on to a purveyor along with the date and time. The purveyor then provides an install key which is compared to an install key number series generated from the install password.

3. Matyas

Matyas teaches a method of enhanced security data cryptography whereby a control vector is associated with a data cryptography key to provide a method of authorization for the uses of the key intended by the originator of the key. The control vector is coupled to a system generated key; however, it is possible, though undesirable, to associate a control vector with a non system generated key, because the control vector is unable to detect the origin of a system key. This second method of associating a control vector with a non system generated key is referred to by the Examiner as the "back-door" method.

4. The Combination of Hoffman and Moore

“There are three possible sources for a motivation to combine references: the nature of the problems to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998). Furthermore, obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so. MPEP § 2143.01 (emphasis added). “Rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” MPEP § 2142.

In the November 16, 2005 Office action, the Examiner failed to establish a motivation for combining Hoffmann and Moore. Instead, on pages 4-5 of the Office action, the Examiner proposed different features shown in Hoffman and Moore. Then, on page 5 of the Office action, the Examiner simply stated that “it would have been obvious for one of ordinary skill in the art at the time the invention to modify Hoffman with the internally generated access install key to enhance security to prevent unauthorized data access operations. Applicant respectfully submits that a rationale of “enhancing security to prevent unauthorized data access operations” is no more than an improper “conclusory statement” in providing support for a finding of obviousness. Absent a clear analysis and rationale for combining references as set forth above in MPEP § 2142-2144, the Examiner’s conclusory statement is merely impermissible “hindsight.”

Applicant respectfully questions why combining Hoffman and Moore would “enhance security to prevent unauthorized data access operations” and why one would be motivated to

do so? What is lacking in Hoffman that would call for a combination with Moore? What advantage would one expect to receive by combining Hoffman and Moore? Should the examiner maintain the rejection under 35 U.S.C. § 103, it is respectfully submitted that he should provide “articulated reasoning with some rational” (as required under MPEP § 2142) for the conclusion that combining Hoffman and Moore would “enhance security to prevent unauthorized data access operations”.

5. The combination of Hoffman, Moore and Matyas

On pages 4-5 of the August 16, 2007 Office action, the examiner admitted that Hoffman “does not explicitly describe a system to bypass security.” However, the examiner argued that “back-door or bypass security methods are well known in the art as exemplified by Matyas.” The examiner then stated that “In light of Matyas, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a bypass of security features since this allows for meter calibration and upgrade that would otherwise be denied access.”

Applicant respectfully submits that the foregoing motivation foregoing motivation to combine Matyas with Hoffman and Moore is improper. What is lacking in Hoffman and Moore that would cause one to combine it with the “back-door” system described in Matyas? **Why would one of skill in the art at the time of the invention been motivated to combine the cited references to provide a utility meter that includes standard meter industry data structures including security data tables, while also configuring the same meter to allow data access operations “without reference to the security data table parameters”?**

Applicant respectfully submits that there was no motivation for such a combination at the time

of the invention, and the examiner's suggestion of such a combination is no more than impermissible "hindsight."

One indicator that the examiner is using impermissible "hindsight" is that the prior art actually "teaches away" from the examiner's proposed combination. When the prior art teaches away from the claimed invention, there is a suggestion of a lack of *prima facie* obviousness. MPEP § 2145; *See In re Fine*, 873 F. 2d 1071 (Fed. Cir. 1988). In particular, **proceeding contrary to accepted wisdom in the art is evidence of nonobviousness.** MPEP § 2145; *citing In re Hedges*, 228 USPQ 685 (Fed. Cir 1983).

The Examiner noted in the April 19, 2007 office action, that according to Matyas, the back door method is "primarily an annoyance" and additional methods should be taken to avoid the back door method. Thus, Matyas discloses that it is desirable and simple to design an architecture that *avoids* the "back door" method. See Matyas, column 15, lines 40-41. By contrast, the bypass component of the present application provides a desirable method of data access that includes such a "back door" method. With this in mind, it can be seen that **Applicant's claimed invention proceeds contrary to the accepted wisdom cited by the examiner in Matyas, and thus it is respectfully submitted that Matyas "teaches away" from the present invention under MPEP § 2145.** Because Matyas teaches away from the claimed invention, the Examiner has not made a *prima facie* case of obviousness, and the Examiner's rejection of claim 1 under 35 U.S.C. § 103 should be withdrawn.

On page 18 of the August 16, 2007 Office action, the examiner appears to argue that because Matyas discloses "a 'back-door' method of generating keys" and because Applicant "circumvents built-in security tables by using a 'back-door' or bypass method of access", that

Matyas does not teach away from the claimed invention. While it is not expressly stated, the examiner appears to imply that if features are disclosed in one or more particular references, these references can not teach away from the claimed invention. In contrast to this, Applicant respectfully submits that the mere fact that elements may be disclosed in particular references does not mean that such references do not teach away from the claimed invention. As set forth in the preceding paragraphs, Applicant's claimed invention proceeds contrary to the accepted wisdom cited in the references. Accordingly, Matyas "teaches away" from the claimed invention. If the examiner continues to suggest that Matyas does not teach away from the claimed invention, he should clearly explain this reasoning.

As set forth above, the references cited by the examiner do not disclose all of the limitations of claim 1. Furthermore, there is no motivation to combine the references, and the cited references actually teach away from the claimed invention. Accordingly, it is respectfully submitted that the Examiner has not made a *prima facie* case of obviousness and the 35 U.S.C. 103(a) rejection of claim 1 should be withdrawn.

V. The Examiner's Rejection of Claim 13 Under 35 U.S.C. § 103(a) Should be Withdrawn

In the April 19, 2007 office action, the Examiner rejected independent claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Hoffman in view of Matyas, in view of Moore, and further in view of Lee. As set forth above concerning claim 1, it is respectfully submitted that the examiner's proposed combination of Hoffman, Matyas and Moore is improper at arriving at the claimed invention. In particular, the examiner has not made a *prima facie* case

for combining Hoffman, Matyas and Moore in arriving at the claimed invention. Accordingly, Applicant respectfully submits that the examiner's rejection of claim 13 under 35 U.S.C. § 103 over Hoffman, Matyas and Moore, should be withdrawn.

VI. The Examiner's Rejection of Claims 2-12 and 14-20 Under 35 U.S.C. § 103(a) and 35 U.S.C. § 101 Should be Withdrawn

In the April 19, 2007 office action, the Examiner rejected dependent claims 2-12 and 14-20 under 35 U.S.C. § 103(a). Each of the above claims depends from and incorporates all of the limitations of one of independent claims 1 or 13. As set forth above, the Examiner's rejection of claims 1 and 13 should be withdrawn. Therefore, because each of dependent claims 2-12 and 14-19 depends from and incorporates all of the limitations of one of independent claims 1 or 13, the Examiner's rejection of dependent claims 2-12 and 14-19 should also be withdrawn for at least the same reasons.

Furthermore, additional reasons exist for allowing claims 2-12 and 14-20. For example, dependent claim 20 includes the limitation of "performing a data access operation without reference to the security tables". **None of the references cited by the examiner disclose a utility meter that includes standard meter industry data structures including security tables where the meter is also configured to perform the step of "performing a data access operation without reference to the security tables".** Furthermore, the examiner has provided no rationale why such an arrangement would be obvious under 35 U.S.C. § 103. Accordingly, the examiner's rejection of claim 20 should be withdrawn for at least this reason.

VII. Conclusion

For all of the foregoing reasons, it is respectfully submitted that the Applicant has made a patentable contribution to the art. Favorable reconsideration and allowance of this application, including pending claims 1-20 and new claims 21 and 22, is therefore respectfully requested.

In the event Applicant has inadvertently overlooked the need for an extension of time or payment of an additional fee, the Applicant conditionally petitions therefore, and authorizes any fee deficiency to be charged to deposit account 13-0014.

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Respectfully submitted,



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